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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,371	06/19/2000	Philip J. Keller	E0889	3850

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EXAMINER

BAROT, BHARAT

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 12/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/597,371

Applicant(s)

KELLER ET AL.

Examiner

Bharat N Barot

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**RESPONSE TO AMENDMENT**

1. Claims 1-25 remain for further examination.

**The New Grounds of Rejection**

2. Applicants' amendments and arguments with respect to claims 1-25 filed on October 02, 2003 (Paper Number 04) have been fully considered but they are deemed to be moot in view of the new grounds of rejection.

**Claim Rejections - 35 USC § 103(a)**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng (U.S. Patent No. 6,571,291) in view of Shim (U.S. Patent No. 6,088,723).

5. As to claim 1, Cheng teaches a method of communicating within a network interface apparatus (abstract and summary of the invention), comprising: creating special frames in a first part of the apparatus, the special frames including an identifier that distinguishes them from other frames passing through the apparatus (figure 1; and column 3 lines 38-50); sending the special frames from the first part to a second part of the apparatus through at least a media access controller of the device, the second part including a physical layer device (figure 2; and column 3 line 27 to column 4 line 2); and identifying the special frames from among frames incoming to the second part, the identifying including examining the incoming frames for the presence of the identifier (figure 2; and column 3 line 51 to column 4 line 14).

However, Cheng does not explicitly teach the step of: extracting physical layer device control information from the special frames at the second part.

Shim explicitly teaches the steps of: sending the special frames from the first part to a second part of the apparatus through at least a media access controller of the device; and extracting physical layer device control information from the special frames at the second part (abstract; figure 1; and column 4 lines 23-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Shim as stated above with the method of communicating within a network interface apparatus of Cheng because it would have increased the transmission efficiency and internal processing speed to improved the network latency.

6. As to claims 2-3, Cheng teaches that the creating includes creating the special frames with the identifier in the position of a destination address, and wherein the identifying includes examining destination addresses of the incoming frames (column 4 lines 30-39); and the identifier is an otherwise unused IEEE address (column 1 lines 17-23; and column 3 lines 27-37).

7. As to claims 4-5, Shim teaches that the controlling the physical layer device using the control information; and the extracting the control information includes changing the contents of memory registers of the second part (figure 1; and column 4 lines 12-50).

8. As to claims 6-7, Cheng teaches that the first part includes an intermediate driver capable of creating the special frames; and the sending the special frames includes passing the special frames through a device driver (column 3 line 38 to column 4 line 14; and column 7 line 64 to column 8 line 61).

9. As to claim 8, Shim teaches that the creating additional special frames in the second part, the additional special frames including an additional identifier, and passing the additional special frames to the first part (figure 1; and column 3 line 54 to column 4 line 17).

10. As to claims 9-10, Cheng teaches that the identifier and the additional identifier are in the form of destination addresses; and the identifier and the additional identifier are the same (column 3 line 60 to column 4 line 2; column 4 lines 30-39; and column 7 lines 19-29).

11. As to claims 11-20, they are also rejected for the same reasons set forth to rejecting claims 1-4 and 6-10 above, since claims 11-20 are merely an apparatus for the method of operation defined in the method claims 1-4 and 6-10. Additionally, Cheng teaches that the special frames are formatted to pass through the second media access controller as if the special frames were data frames (column 3 line 38 to column 4 line 14; and column 7 line 64 to column 8 line 61).

12. As to claims 21-25, they are also rejected for the same reasons set forth to rejecting claims 1-2, 4, 6-10, and 14 above, since claims 21-25 are merely an apparatus for the method of operation defined in the method claims 12, 4, and 6-10.

#### **Additional References**

13. The following references are cited by the examiner as of general interest.

- a. Cheng, U.S. Patent No. 6,662,234.
- b. Booth et al, U.S. Patent No. 6,516,352.

**Contact Information**

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bharat Barot whose telephone number is (703) 305-4092. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, An, Meng-Ai, can be reached at (703) 305-9678. A central official fax number is (703) 872-9306.

Any inquiry of general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-3900.

Patent Examiner Bharat Barot

Art Unit 2154

December 02, 2003

*Bharat Barot*

**BHARAT BAROT  
PRIMARY EXAMINER**